

sector 4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

EDWARD J. FIORE

Serial No.: 09/688,717

Filed: October 16, 2000

For: Arbitrated Loop Port Switching

Attorney Docket No.: 98-046-NSC (STK98046PUS)



Group Art Unit: 2664

Examiner: not known

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**OFFICE OF PETITIONS
DEPUTY A/C PATENTS**

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**PETITION UNDER 37 C.F.R. § 1.47(b)
FILING WHEN A SINGLE INVENTOR
REFUSES TO SIGN**

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231

Sir:

Pursuant to 37 C.F.R. § 1.47(b), this Petition requests acceptance of a Declaration signed on behalf of Storage Technology Corporation (StorageTek) due to the refusal by Edward J. Fiore, the sole inventor of the above-captioned patent application, to sign the Declaration.

Following are facts pertinent to this Petition. Proof of these facts is provided by the accompanying Declarations of Facts, signed by Mark D. Chuey and Timothy R. Schulte.

1. Edward Fiore works for Cisco Systems, Inc. (Cisco), which is involved in litigation against the assignee, StorageTek.
2. Mr. Fiore agreed "to assign all the Employee's rights, title and interest in and to all Intellectual Property and any applications filed therefor to StorageTek" in a Property Rights Agreement signed by Mr. Fiore on May 5, 1996.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Attention Group Director, Group 2821, Commissioner for Patents, United States Patent and Trademark Office, Washington, D.C. 20231 on:

May 8, 2001
Date of Deposit

Mark D. Chuey
Name of Person Signing


Signature

3. Mr. Fiore left StorageTek to work for NuSpeed, Inc. on December 30, 1999. NuSpeed was subsequently acquired by Cisco.
4. During the period between when Mr. Fiore signed the above-mentioned property rights agreement and when Mr. Fiore left StorageTek, Mr. Fiore conceived the invention that is the subject of the above-captioned patent application.
5. The above-captioned patent application was filed with the U.S. Patent and Trademark Office on October 16, 2000. The application was filed at this time to prevent irreparable damage that would have occurred if Cisco began practicing the invention in a product competing with a StorageTek system.
6. On January 9, 2001, Mr. Fiore was sent a copy of the patent application together with a Declaration and an Assignment via certified mail.
7. On January 15, 2001, Mr. Fiore sent Timothy Schulte, Assistant General Counsel for StorageTek, an electronic mail citing U.S. Patent Nos. 5,751,715 and 6,118,776. The mail message stated: "This art would make my Patent void." The mail message also requested that Mr. Schulte call Mr. Fiore.
8. Mr. Schulte forwarded the electronic mail to Brooks & Kushman, P.C., and the electronic mail was received by Mark Chuey, a patent agent at Brooks & Kushman, on January 16, 2001. Mr. Chuey called Mr. Fiore on the same day and left a message requesting that Mr. Fiore return the call.
9. Joe Hammell, who identified himself as an attorney with Dorsey & Whitney, LLP representing Cisco, telephoned Mark Chuey on January 19, 2001. Mr. Hammell asked Mr. Chuey to have no further contact with any former StorageTek employee now working for Cisco. Mr. Hammell also indicated that he would send a letter indicating that no former StorageTek employee currently working for Cisco would sign any document related to a StorageTek patent application.
10. When no letter was received, Mr. Chuey sent a letter to Joe Hammell on February 23, 2001 summarizing their telephone conversation, including the understanding that Mr. Fiore refused to sign any declaration or assignment.
11. Mr. Hammell responded by letter on March 2, 2001. However, this letter did not indicate whether or not Mr. Fiore intended to sign the Declaration.

12. On March 28, 2001, Mr. Chuey sent a second letter to Mr. Hammell requesting Mr. Hammell to forward the enclosed Declaration and Assignment to Mr. Fiore for signature. The letter also asked Mr. Hammell to verify Mr. Fiore's address. The letter indicated, erroneously, that Mr. Chuey had not previously forwarded a copy of the application and formal papers to Mr. Fiore. The letter further stated that, if no response to the contrary was received by April 7, 2001, it would be assumed that Mr. Fiore refused to sign.
13. On March 29, 2001, Mr. Hammell responded with a letter indicating that he forwarded the documents to Mr. Fiore. Mr. Hammell also indicated that the April 7 deadline was not reasonable since Mr. Fiore had not been sent a copy of the application. Mr. Hammell further indicated that, to his knowledge, Mr. Fiore had not refused to sign any documents.
14. On March 30, 2001, Mr. Chuey responded with a letter forwarding his letter of January 9, 2001 and Mr. Fiore's signed receipt indicating that Mr. Fiore had received the January 9 letter together with the Application, Declaration and Assignment. Mr. Chuey's letter to Mr. Hammell included a statement that, in light of the almost three months Mr. Fiore had to review the application, a deadline of April 7 was appropriate.
15. On April 4, 2001, Mr. Hammell responded with a letter in which Mr. Hammell provided the following statement:

Ed Fiore has asked me to inform you that the patent documents you asked him to sign relate to technology which is covered by existing patents, specifically US Patent 6,118,776 held by Vixel, and US Patent 5,751,715 held by Gadzoox. I am enclosing some documents relating to these existing patents.

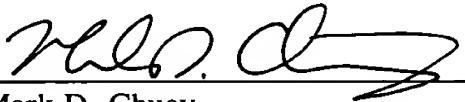
16. The last known address for Mr. Fiore is as follows:

Edward J. Fiore
7861 151st Lane NW
Ramsey, Minnesota 55303

17. The Declaration, filed together with this Petition, is signed by Mr. Schulte. Mr. Schulte is authorized to represent StorageTek in intellectual property matters, including signing a Declaration on behalf of StorageTek.

A check in the amount of \$130 is enclosed to cover the fee under 37 C.F.R. § 1.17(i). Please charge any additional fees or credit any overpayment as a result of filing this paper to Deposit Account No. 19-4545. A duplicate copy of this Petition is enclosed for that purpose.

Storage Technology Corporation
(Assignee)

By: 
Mark D. Chuey
Reg. No. 42,415
Attorney/Agent for Applicant

Date: May 8, 2001

BROOKS & KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
Phone: 248-358-4400
Fax: 248-358-3351